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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,304	07/22/2003	Masafumi Matsuda	S01459.70053.US	7805

7590 08/22/2006

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EXAMINER

LY, ANH

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/624,304	Applicant(s) MATSUDA ET AL.	
	Examiner Anh Ly	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/13/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is response to Applicants' Preliminary Amendment filed on 09/13/2004.
2. Claims 1-18 are pending in this Application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 7, 8, 9, 10, 12, 14, 15, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the **specification** in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Because "reproduction status", "content identification" and "second data processing apparatus" does not support in the **section of the instant specification**. Also, it does not support for "if operating means ... while ... generates ..." (line 5-8 of claim 7). Applicants are advised to amend the claims to provide a clear and concise language to the "second data processing apparatus" and "if ... while ... generates ..." for their intended use in order to one of ordinary skill in the art to make and use the invention as claim. Applicant is reminded that no new subject matter should be added.

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5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "if ... "not while"". In the body of claim is silent about NOT WHILE step/process.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10, 11, 16 and 17 are rejected under 35 U.S.C. 101 because:

The claims 10, and 17 are program per se. They are descriptive material per se and not statutory because they are not physical things. They are not a process. (Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 and Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035).

Claims 11 and 16 are lacking of tangible result and useful result. The bodies of claims are missing the conveying steps. Both are having abstract idea, and non-functional data such as software performing the steps and without conveying the actions or result to the real world. Thus, they are not a practical utility or a practical application.

Priority

7. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Objections

8. Claims 3 and 14 are objected to because of the following informalities:

In line 2 of claim 3, "a content data item" should replace with "the content data item"

In line 3 of claim 14, "a second data processing apparatus" should replace with "the second data processing apparatus". Appropriate corrections are required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2002/0090206 A1 of Kikuchi et al. (hereinafter Kikuchi) in view of Pub. No.: US 2002/0132612 A1 of Ishii.

With respect to claim 1, Kikuchi teaches a data processing apparatus (a reproducing apparatus for reproducing data from the recording medium: abstract and sections 0076-0077; also see section 0002), comprising:

reproducing means for reproducing each of a plurality of content data items (reproducing data items such as movie, music or audio files from a recording medium such as optical disk: sections 0076-0077 and 0093); and

reproduction status detecting means for detecting status of each content data item being reproduced by said reproducing means (detecting data items from the disk by detecting section: sections 0191-0192 and 0231-0232).

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting section for detecting audio data stored in the disk. Kikuchi does clearly teaches selecting means for selecting a content data item being reproduced by said reproducing means depending on a reproduction status of said content data item detected by said reproduction status detecting means; content identification data

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generating means for generating content identification data for identifying the content data item selected by said selecting means from said plurality of content data items; and transmitting means for transmitting to a second data processing apparatus said content identification data generated by said content identification data generating means.

However, Ishii teaches selecting content data item such as music data and/or image data (figs. 3 & 4, sections 0080-0082) and reproducing the content data transmitted to/from a second device receiving identification data and transmitting content identification data (sections 0012, 0014-0017 and 0019-0022).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).

With respect to claim 2, Kikuchi teach an apparatus as discussed in claim 1.

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting

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section for detecting audio data stored in the disk. Kikuchi does clearly teaches wherein said transmitting means transmits together with said content identification data the content data item identified by said content identification data.

However, Ishii teaches transmitting the content data together with content identification (abstract, sections 0011-0012).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).

With respect to claim 3, Kikuchi teaches wherein said reproduction status detecting means detects a content data item having been reproduced longer than a predetermined time period (sections 0231 and 0232).

With respect to claim 4, Kikuchi teaches wherein said reproduction status detecting means detects a specific part of the content data item being reproduced (sections 0191-0192 and 0262).

With respect to claim 5, Kikuchi teaches wherein said reproduction status detecting means detects the content data item having been reproduced from beginning to end (sections 0123-0127).

With respect to claim 6, Kikuchi teaches wherein said reproduction status detecting means detects, during reproduction of the content data item, the number of times said content data item has been reproduced from the beginning thereof (sections 0123-0127).

With respect to claim 7, Kikuchi teaches a data processing apparatus (a reproducing apparatus for reproducing data from the recording medium: abstract and sections 0076-0077; also see section 0002) comprising:

reproducing means for reproducing each of a plurality of content data items (reproducing data items such as movie, music or audio files from a recording medium such as optical disk: sections 0076-0077 and 0093).

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting section for detecting audio data stored in the disk. Kikuchi does clearly teaches operating means for designating selection of a content data item being reproduced by said reproducing means; content identification data generating means which, if said operating means is operated for the designation while the content data item is being reproduced by said reproducing means, generates content identification data for identifying the currently reproduced content data item from among said plurality of content data items; and transmitting means for

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transmitting to a second data processing apparatus said content identification data generated by said content identification data generating means.

However, Ishii teaches selecting content data item such as music data and/or image data (figs. 3 & 4, sections 0080-0082) and reproducing the content data transmitted to/from a second device receiving identification data and transmitting content identification data (sections 0012, 0014-0017 and 0019-0022).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).

With respect to claim 8, Kikuchi teaches a data processing apparatus as discussed in claim 7.

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting section for detecting audio data stored in the disk. Kikuchi does clearly teaches data processing apparatus searching means for searching for and detecting a second data processing apparatus; and wherein said transmitting means

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transmits said content identification data to said second data processing apparatus when said second data processing apparatus has been searched for and detected by said data processing apparatus searching means.

However, Ishii teaches reproducing the content data transmitted to/from a second device receiving identification data and transmitting content identification data (sections 0012, 0014-0017 and 0019-0022) and retrieving data from disk 9 (sections 0045-0048).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).

Claim 9 is essentially the same as claim 1 except that it is directed to a method rather than an apparatus, and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 10 is essentially the same as claim 1 except that it is directed to a program rather than an apparatus, and is rejected for the same reason as applied to the claim 1 hereinabove.

With respect to claim 11, Kikuchi teaches a data processing apparatus (a reproducing apparatus for reproducing data from the recording medium: abstract and sections 0076-0077; also see section 0002) comprising:

receiving means for receiving a plurality of content identification data items; reproducing means for reproducing a content data item identified by each of said content identification data items received by said receiving means; and reproduction status detecting means for detecting status of each content data item being reproduced by said reproducing means (reproducing data items such as movie, music or audio files from a recording medium such as optical disk: sections 0076-0077 and 0093; and detecting data items from the disk by detecting section: sections 0191-0192 and 0231-0232).

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting section for detecting audio data stored in the disk. Kikuchi does clearly teaches selecting means for selecting the content data item identified by any one of said plurality of content identification data items and reproduced by said reproducing means, depending on the reproduction status of said content data item detected by said reproduction status detecting means.

However, Ishii teaches selecting content data item such as music data and/or image data (figs. 3 & 4, sections 0052, 0072 and 0080-0082).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it

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motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).

With respect to claims 12, 14 and 15, Kikuchi teaches a data processing apparatus as discussed in claim 11.

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting section for detecting audio data stored in the disk. Kikuchi does clearly teaches wherein said plurality of content identification data items have been selected by a second data processing apparatus; comprising data processing apparatus searching means for searching for and detecting a second data processing apparatus; and wherein said receiving means receives said plurality of content identification data from said second data processing apparatus when said second data processing apparatus has been searched for and detected by said data processing apparatus searching means; and further comprising transmitting means for transmitting the content data item selected by said selecting means, to said second data processing apparatus searched for and detected by said data processing apparatus searching means.

However, Ishii teaches reproducing the content data items being selected or transmitted by a second device receiving identification data and transmitting

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content identification data (sections 0012, 0014-0017 and 0019-0022); and retrieving data from disk 9sections 0045-0048).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).

With respect to claim 13, Kikuchi teaches wherein said receiving means receives each of said plurality of content identification data items depending on the number of times the content data item has been reproduced by said reproducing means (sections 00170076-0077 and 0093).

Claim 16 is essentially the same as claim 11 except that it is directed to a method rather than an apparatus, and is rejected for the same reason as applied to the claim 11 hereinabove.

Claim 17 is essentially the same as claim 11 except that it is directed to a program rather than an apparatus, and is rejected for the same reason as applied to the claim 11 hereinabove.

With respect to claim 18, Kikuchi teaches a data processing system having a first and a second data processing apparatus; wherein said first data

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processing apparatus comprises; first reproducing means for reproducing each of a plurality of content data items; first reproduction status detecting means for detecting status of each content data item being reproduced by said first reproducing means; and receiving means for receiving said content identification data from said first data processing apparatus; second reproducing means for reproducing the content data item identified by said content identification data received by said receiving means second reproduction status detecting means for detecting status of said content data item being reproduced by said second reproducing means; a (a reproducing apparatus for reproducing data from the recording medium: abstract and sections 0076-0077; also see section 0002; reproducing data items such as movie, music or audio files from a recording medium such as optical disk: sections 0076-0077 and 0093; and detecting data items from the disk by detecting section: sections 0191-0192 and 0231-0232).

Kikuchi teaches reproducing apparatus that reproduces the data items, which are movie or music or audio files stored in the optical disk; detecting section for detecting audio data stored in the disk. Kikuchi does clearly teach first selecting means for selecting a content data item being reproduced by said first reproducing means depending on a reproduction status of said content data item detected by said first reproduction status detecting means; content identification data generating means for generating content identification data for identifying the content data item selected by said first selecting means from said plurality of content data items; and transmitting means for externally transmitting said content identification data; and wherein said second data processing apparatus

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comprises: and second selecting means for selecting said content data item being reproduced by said second reproducing means depending on a reproduction status of said content data item detected by said second reproduction status detecting means.

However, Ishii teaches selecting content data item such as music data and/or image data (figs. 3 & 4, sections 0080-0082) and reproducing the content data transmitted to/from a second device receiving identification data and transmitting content identification data (sections 0012, 0014-0017 and 0019-0022).


Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Kikuchi with the teachings of Ishii. One having ordinary skill in the art would have found it motivated to utilize the use of selecting a content data item, and generating content for identifying the content as disclosed (Ishii's sections 0014-0017 and 0019-0022), into the system of Kikuchi for the purpose of transmitting content data item, receiving data to second device for reproducing the content data, thereby, enabling the user receiving immediately (Ishii's sections 0001, 0006 and 0012).


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Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV (**Written Authorization being given by Applicant (MPEP 502.03 [R-2])) or fax to (571) 273-4039 (Examiner's personal Fax No.)**. The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107 or **Primary Examiner: Jean Corrielus (571) 272-4032**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

ANH LY 
AUG. 8th, 2006


JEAN M. CORRIELUS
PRIMARY EXAMINER